

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

THI *et al.*

Appl. No.: 09/703,264

Filed: October 31, 2000

For: **Method and System for Stereo
Echo Cancellation for VOIP
Communications Systems**

Confirmation No.: 9016

Art Unit: 2614

Examiner: Jamal, Alexander

Atty. Docket: 2875.0490001

**Petition Under M.P.E.P. § 706.07(d)
to Withdraw Finality of Office Action**

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request reconsideration of the finality of the rejection of the last Office Action dated **July 10, 2008**. The Examiner states that Applicants' amendments necessitated the new ground of rejection presented in the final Office Action. (*See Office Action at p. 3*). Applicants respectfully disagree and file this petition to withdraw the finality of the Office Action.

Under present practice, second or subsequent actions on the merits can be made final, except where the Examiner introduces a new ground of rejection that is neither necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c). Here, Applicants respectfully assert that the Examiner introduced a new ground of rejection that was neither necessitated by Applicants' amendment of the claims. Therefore, the finality of the Office Action was premature. *M.P.E.P. §§ 706.07(a), (c)*.

Atty. Dkt. No. 2857.0490001

There is a new, improperly final, rejection under 35 U.S.C. § 112.

In the final office action, for the first time, the Examiner raises a rejection under 35 U.S.C. § 112 for lack of enablement. This rejection was not necessitated by Applicants' amendment. To the extent that there is a question about whether the claims are enabled, this rejection could have been raised in the first office action. Indeed, raising an enablement rejection for the first time in a final office action compromises Applicants' ability to submit evidence to rebut such assertions. Applicants' amendment to the claims did not necessitate this rejection.

In the Office Action reply filed March 26, 2008, Applicants amended independent claims 1, 11, 22, 33 and 37 to add the feature "caused by imperfect impedance matching of network transmission sections" with respect to the electrical echo, and changed "dynamically adapted" to "adapted." *See Office Action reply filed March 26, 2008.* The first amendment refers to a cause of an electrical echo, and the second amendment refers to the adaptive filter. Neither of these amendments has any bearing on the alleged issue of enablement, namely "a hybrid and speaker microphone coupled to the same driving point."

In this same Office Action reply, Applicants also amended dependent claims 4, 21, 32, 35 and 39 to add the feature "in presence of the secondary audio signal." *See Office Action reply filed March 26, 2008.* This amendment refers to "detecting speech in the near end signal." Nowhere does this amendment have any bearing on the alleged issue of enablement, namely "a hybrid and speaker microphone coupled to the same driving point."

Finally, in this same Office Action reply, FIG. 7 was not amended. In fact, FIG. 7 has never been amended and is the same figure as originally filed on October 31, 2000. *See original filing dated October 31, 2000.*

Summary

For the above reasons, the finality of the Office Action is premature and thus improper and should be withdrawn. Early notice to this effect is respectfully requested. It is not believed that a fee is required. However, if a fee is needed, the United States Patent and Trademark Office is hereby authorized to debit our Deposit Account No. 19-0036 for all necessary fees.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Michael D. Specht
Attorney for Applicants
Registration No. 54,463

Date: October 29, 2008

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600